

REMARKS

This application pertains to a novel pressure-sensitive adhesive composition having an outgassing level of not more than 50 µg/g, and to a process for producing it.

Claims 1-3 and 5-13 are pending, claim 4 being canceled by this amendment. The limitations of claim 3 have been added to claim 3.

The claims are being amended to more clearly recite that the pressure-sensitive adhesive composition comprises a residual volatile component fraction of less than 50 µg/g. This therefore is not merely a property or function, but rather it is a description of the actual composition of material. Support for the amendment can be found at page 4, lines 17-19. No new matter is presented, and no new issues are raised. This amendment should therefore not be refused entry.

Claims 1, 2 and 9-11 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harder et al (DE 19807752, corresponding to US 6,432,529).

Applicants have previously pointed out that the adhesives disclosed by the '752 reference are said to have a residual solvent level of less than 1% by weight, which is far from 50 µg/g.

The Examiner contends, however, that since, as she sees it, Harder discloses the same composition and teaches that his composition is low fogging, his adhesives would inherently possess the claimed outgassing level.

The Examiner's contention is totally unsupported by anything that can be found anywhere within the reference itself. Nowhere does Harder teach or suggest anything about a residual volatile component fraction of less than 50  $\mu\text{g/g}$ .

If the undersigned calculates correctly, Harder's "less than 1%" means less than 10,000  $\mu\text{g/g}$ . That's 200 times the level Applicants' claim!

The mere fact that Harder refers to his compositions as being "low" in fogging, does not equate to a residual volatile component fraction of less than 50  $\mu\text{g/g}$ .

The Examiner states that "presumably, Harder et al's adhesive would inherently possess the claimed outgassing level.

A presumption is not a teaching.

Harder does not in any way teach or suggest a residual volatile component fraction of less than 50  $\mu\text{g/g}$ .

In this regard, the Examiner will note the teaching, at page 7, lines 14-16 that:

*Only by means of the inventive process, in particular by an appropriate combination of concentration and postpurification, is it possible to obtain the inventive pressure-sensitive adhesive composition having the required outgassing levels.*

Nothing in the Harder reference discloses said process, and Harder therefore cannot possibly enable the preparation of the claimed pressure-sensitive adhesive.

Although the Examiner argues that claims 1-2 and 9-10 do not include the process limitations, same is not necessary to distinguish over Harder. To be an effective reference, a reference must be **enabling**. As discussed above, not only does Harder fail to disclose a residual volatile component fraction of less than 50 µg/g, but is also further deficient in failing to provide anything that would enable one to arrive at such a composition.

The rejection of Claims 1, 2 and 9-11 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harder et al (DE 19807752, corresponding to US 6,432,529) should therefore now be withdrawn.

Claims 1-13 (now claims 1-3 and 5-13) stand rejected under 35 U.S.C. 103(a) as obvious over Harder DE 19807752 (=US 6,432,529) in view of Harder DE 4313008 (=US 6,613,870). The Examiner views Harder '008 as teaching a method by which the adhesives of Harder '529 could be treated, presumably to reach the low outgassing level claimed by Applicants.

Neither Harder reference teaches or suggests anything at all about a residual volatile component fraction of less than 50 µg/g. To the contrary, Harder '008 exemplifies his compositions as having proportions of volatile substances of 0.8% (i.e., 8000 µg/g), a far cry from Applicants' outgassing level of 50 µg/g.

The Examiner argues that Harder '088 is not relied on for the teaching of being non-fogging, but is relied on to show that the claimed method of making the adhesive composition is known. However, nothing in either Harder reference would teach or suggest the combination of concentration and postpurification referred to by Applicants at page 7, lines 14-16 and neither reference is therefore enabling for the claimed self-adhesive compositions which have a residual volatile component fraction of less than 50 µg/g.

Accordingly, Applicants' claims cannot be seen as obvious over the Harder references, whether taken individually or in combination, and the rejection of claims 1-13 under 35 U.S.C. 103(a) as obvious over Harder DE 19807752 (=US 6,432,529) in view of Harder DE 4313008 (=US 6,613,870) should now be withdrawn.

In view of the present amendments and remarks it is believed that claims 1-3 and 5-13 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME


If any extension of time for this response is required, applicant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

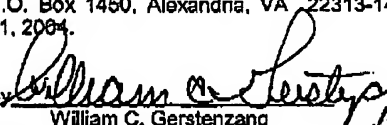
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By   
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Date August 31, 2004

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